

REMARKS

The Examiner is respectfully requested to enter this Reply After Final in that it raises no new issues. Alternatively, the Examiner is respectfully requested to enter this Reply After Final in that it places the application in better form for Appeal.

Status of the Claims

Claims 17-29 and 33 are currently pending in the above identified application. Claims 30-32 have been canceled. Claim 33 has been added. Support for claim 33 is found in the specification at page 4, line 26 to page 6, line 3. Claims 18 has been amended to change dependency to new claim 33. Claims 18, 20 and 29 have been amended to change the number of carbon atoms to 10 to 32. Support for this amendment is found at page 4, line 24. No new matter has been added by the above claim amendments. In addition, no new issues are raised by the above claim amendments. As such, Applicants respectfully request the entry of the above amendments.

Election/Restriction

The Examiner restricts claims 31 and 32 as being directed to a separately patentable invention. As such, Applicants cancel claims 31 and 32.

Rejections under 35 USC 102(b)

The Examiner rejects claims 18 and 29 as anticipated by Kigawa '434. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants amend claims 18 and 29 to recite "a dimerdiol ester of a monocarboxylic acid having 10 to 32 carbon atoms". As such, the present invention does not contain esters of α,β -unsaturated carboxylic acids having 3-8 carbon atoms. Since, the dimerdiol esters of Kigawa '434 comprise 3-8 carbon atoms, the present invention is not anticipated by Kigawa '434 and the rejection should be withdrawn.

Rejections under 35 USC 103(a)

The Examiner rejects claims 17-28 and 29-30 as obvious over Ansmann '978 in view of Hartmann '190 or Akrongold '550 and further in view of Bernhardt '054 or Clum '263. Applicants traverse the rejection and respectfully request the withdrawal thereof.

The Examiner relies on Ansmann '978 for disclosing an emulsifier used in the production of cosmetic formulations. However, Applicants submit that Ansmann '978 does not disclose a dimmer acid. Ansmann '978 discloses an emulsifier that is a mixture of alkyl and/or alkenyl oligoglycoside and fatty alcohols. The emulsifier is not a fatty acid ester and has no relation to a

dimerdiol ester. Moreover, the oil in Ansmann '978 is an oil constituting an O/W type emulsion (see column 4, lines 39-40) and not an emulsifier as suggested by the Examiner.

Ansmann discloses at column 3 under the heading of "Commercial Applications" that, "[t]he emulsifiers according to the invention enable stable o/w emulsions to be produced. In contrast to known emulsifiers, which have a higher fatty alcohol content and a lower glucoside content, highly viscous creams, for example may even be produced with low wax concentrations which results in a significant improvement in the sensorial properties of the product." Ansmann notes that the improvement in the sensorial properties is attributable to the emulsifier and not the use of oil alone. From this passage one of ordinary skill in the art would know that the oils disclosed at column 4, lines 39-56 will not produce the improved sensorial properties alone. The improvement is only achieved when the oil is used in conjunction with the emulsifier.

As such, Applicants submit that one of ordinary skill in the art would not be motivated to replace the alcohol moieties of the esters of fatty acids disclosed in Akrongold at column 1, lines 56-61 with dimerdiol to arrive at a cosmetic composition.

Moreover, the cosmetic composition of Ansmann is completely different from the cosmetic of Akrongold. The number of carbon atoms are different in the different compositions. As such, one of ordinary skill in the art would not be motivated to combine

the references. For this additional reason, Ansmann cannot be combined with Akrongold to arrive at the present invention.

In rebuttal to the Examiner's comments regarding the combination of Ansmann and Hartmann, Applicants submit again that the oils disclosed in Ansmann are not emulsifiers. In addition, the oily phase disclosed in Hartmann at column 5, lines 29-33 is not an emulsifier. The component b of the emulsifier disclosed at column 6, line 66 to column 7, line 36 of Hartmann is different from the oily phase disclosed at column 5, lines 29-33. The component b does not include dimerdiol ester, since component b is hydrophilic as indicated by the HLB values of from 2 to 10, preferably 3 to 7. Dimerdiol esters of the present invention are hydrophobic having HLB values of almost 0.

Moreover, Hartmann fails to disclose or suggest using the oily phase and component b in a cosmetic although it is disclosed that the composition may contain polyhydric alcohols with long-chain fatty acids. However, Applicants submit that there are many kinds of polyhydric alcohols with long-chain fatty acids and the disclosure of but one does not motivate one of ordinary skill in the art to use with any expectation of success any other polyhydric alcohol with long-chain fatty acids.

The oily phase in Hartmann is used as an oil component in w/o emulsions where polymerization of N-vinyl amide is conducted. See column 4, lines 54-55 and column 5, lines 13-33. Component b is used as a component of an emulsifier for forming w/o emulsions where polymerization of N-vinyl amide is conducted. The produced polymer emulsion of N-vinyl amide is used as a flocculating agent, retention agent and a dispersing agent. These uses do not even remotely hint at use as a cosmetic. Therefore, one of ordinary skill in the art would not be motivated to combine the oily phase and component b of Hartmann with the cosmetic of Ansmann because the disclosures are from unrelated fields.

Pursuant to In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), the references in combination must be analogous and thus within the field of the invention or pertinent to the problem the inventor is attempting to solve. Applicants submit that as Hartmann has nothing to do with cosmetics and does not pertain to any issues to be solved to arrive at the present invention, the reference is not analogous art to the present invention and is also not analogous with Ansmann. Thus, Hartmann should be removed as a reference.

Applicants further submit the attached Table, which illustrates the disclosures of the primary and secondary references and how the references are directed to different

technology areas, to demonstrate that one of ordinary skill in the art would not be motivated to combine Ansmann with Akrongold or Hartmann.

Lastly, Applicants submit that "dimer diol" and "trimer diol" discussed at column 4, line 49 are different compounds from "dimerdiol" as used in the present invention. In fact, "trimer diol" is meaningless within the meaning of the present invention. According to the present invention, "timer diol" would be interpreted as "trimer triol". It appears, however, that dimer diol as used in Ansmann is represented by the formula HO-Ar-O-Ar-OH, wherein Ar is ethylene. It also appears that trimer diol is represented by the formula HO-Ar-O-Ar-O-Ar-H, wherein Ar is ethylene. Dimer diol and trimer diol as used in Ansmann are both known for uses in cosmetics. However, this is not the dimerdiol of the present invention.

Rejection under 35 USC 112, second paragraph

The Examiner rejects claims 29 and 30 as indefinite. Applicants amend claim 29 to delete the allegedly offensive phrase. Thus, the rejection should be withdrawn. Applicants also cancel claim 30. As such, the rejection is moot.

Conclusion

As Applicants have addressed and overcome all rejections by claim amendments and arguments, Applicants respectfully request that the rejections be withdrawn and the claims be allowed.

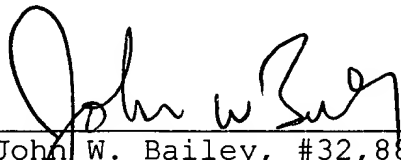
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 
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✓
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Attachment: Version with Markings to Show Changes Made
Table of Ansmann, Akrongold and Hartmann

(Rev. 02/20/02)



Application No. 09/604,768

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

18. (Twice Amended) The cosmetic or an external agent according to claim [29] 33, wherein the dimerdiol ester is of a monocarboxylic acid having [4 to 34] 10 to 32 carbon atoms.

20. (Amended) The cosmetic or an external agent according to claim 18, wherein the monocarboxylic acid comprises a linear unsaturated fatty acid having [8-34] 10 to 32 carbon atoms.

29. (Amended) A cosmetic or an external agent comprising a dimerdiol ester of a monocarboxylic acid having [4 to 34] 10 to 32 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid[, wherein said cosmetic or external agent is a skin cosmetic or external skin agent].

Claim 33 has been added.

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Table



	What is disclosed:		Described or suggested use & effect
Ansmann et al	Emulsifier column 1, lines 40-47, etc.	a mixture of alkyl and/or alkenyl oligoglycoside and fatty alcohols <u>(no relation to dimerdiol fatty acid esters)</u>	Improvement in the sensorial properties (=good for cosmetics)
	the Oil (column 4, lines 39-56)	an oil constituting an O/W type emulsion (including dimerdiol fatty acid esters)not dimerdiol esters	1) <u>not good</u> (for cosmetics) unless it is co-used with the emulsifier. (<u>negative teaching</u>) 2) O/W type emulsion, i.e. used with water and in a liquid state
Akrongold et al	the Oil (column 1, lines 56-61)	Ester of fatty acid such as isopropyl myristate, etc. (dimerdiol ester is not disclosed.)	For cosmetics <u>powder form</u> (not in a liquid state) with urea and an inorganic pigment
Hartmann et al	Emulsifier =the component (b) (column 6, line 66-column 7, line 36) the Oily phase (column 5, lines 29-33)	1) <u>not include dimerdiol ester</u> since its HLB values of from 2 to 10. (column 7, lines 2-3, HLB of dimerdiol ester should be 0.) Aliphatic dicarboxylic acid esters included	a component of an emulsifier for forming water-in-oil emulsions where polymerization of N-vinyl amide (<u>no relation to cosmetics</u>) a component of water-in-oil emulsions where polymerization of N-vinyl amide (<u>no relation to cosmetics</u>)

Difference in intended uses, effects, using forms and the like should be considered in considering obviousness.